

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Horton *et al.*

Appl. No. 09/557,907

Filed: April 21, 2000

For: **Treatment of Cancer Using
Cytokine-Expressing
Polynucleotides and Compositions
Therefor**

Confirmation No. N/A

Art Unit: 1633

Examiner: Wilson, M

Atty. Docket: 1530.0060004/EKS/EJH

Reply To Restriction Requirement

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated June 20, 2001 (P.T.O. File Wrapper Paper No. 8), requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect, with traverse, to prosecute the invention of Group I, represented by claims 1-50, 52-56, 58-64, 66-75, 77-87, 89-94, and 96-103. Applicants reserve the right to pursue the non-elected claims in related applications.

With respect to the Examiner's division of the claims into two groups and the reasons stated therefor, Applicants respectfully traverse. Groups I and II are related as between DNA molecules which encode cytokines (Group I) and corresponding mRNA molecules (Group II). Even assuming, *arguendo*, that Groups I and II represent distinct or independent inventions, Applicants submit that to search and examine the subject matter of both Groups together would not be a serious burden on the Examiner.

Applicants further submit that publications disclosing the methods of Group I would

overlap with publications disclosing the method of Group II. For example, publications which disclose the DNA molecules which encode cytokines would normally also disclose the corresponding mRNA molecules, thereby making it a simple matter for the Examiner to search and examine methods of treating cancer using DNA encoding cytokines as in claims 1-50, 52-56, 58-64, 66-75, 77-87, 89-94, and 96-103 of Group I, and methods of treating cancer using mRNA encoding cytokines as in claims 51-55, 57-63, 65-74, 76-86, 88-93, and 95-103 of Group II. The M.P.E.P. § 803 (Seventh Edition, Rev. July, 1998) states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, in view of the M.P.E.P. § 803, Applicants respectfully request that the claims of Groups I and II be searched and examined in the captioned application. Applicants retain the right to petition from the Restriction Requirement under 37 C.F.R. § 1.144. Reconsideration and withdrawal of the Restriction Requirement, and examination and allowance of all pending claims, are respectfully requested.

In addition to the restriction requirement, the Examiner required an election of one species comprising a specific cytokine or combination of cytokines. Applicants hereby provisionally elect to prosecute the species comprising IFN- α . Claims 1-10, 35-51, and 59-103 are generic, and claims 15-18 and 29-34 read on the provisionally elected species. This election is made without traverse. Applicants assert the right to claim additional species in the event that a generic claim thereto is found to be allowable in accordance with 37 C.F.R. § 1.141(a). This election is made without prejudice to or

disclaimer of the other claims or inventions disclosed. Consideration and allowance of all pending claims are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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